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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/986,586
Filing Date: November 09, 2001
Appellant(s): TSUCHIDA ET AL.

Will Lyddane
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 23, 2004 appealing from the Office action mailed January 21, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 3, 4, 5, 10, 13, 15, 16, 17, 19, 21, 22, 23 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). However, claim 10 was cancelled in the amendment after final.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,375,571	Ohnuma et al.	4-2002
6,347,993	Kondo et al.	2-2003

Final Fantasy VIII video game by SquareSoft (agreed upon prior art between Examiner and Appellant, because no challenge has been raise by Appellant.)

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 13-15, and 19-21 are rejected under 35 U.S.C. 103(a) as being anticipated by Ohnuma et al. (US Patent No. 6,375,571) in view of Final Fantasy VIII (FFVIII).

For clarification the Examiner notes that Final Fantasy VIII, while not specifically mentioned in the 1st line of the rejection, was used as a reference to reject claims 1-3, 13-15 and 19-21 in the final rejection mailed on January 21, 2004 as is clearly seen from the body of the final rejection. Furthermore, the Examiner noted this typographical oversight in the Advisory Action mailed out on May 14, 2004. Also in Applicant's appeal brief, he clearly agrees that Final Fantasy VIII was used as a reference in the final office action to reject the claims. Therefore, the use of Final Fantasy VIII now, in the Examiner's Answer does not constitute a new ground of rejection.

Ohnuma et al. disclose control method relating to a computer-readable recording medium having a program of a video game recorded therein (FIG 6) wherein player characters are assigned predetermined parameters in the form of items that can be changed when the player character defeats an enemy character (FIG 15). This computer-readable recording medium is in the form of a gaming apparatus and the program inherently controls the processing that occurs within the device.

Upon execution, the computer will compare an amount of damage inflicted on the enemy character by the player character each time the player character attacks, including before and immediately before the player character defeats the enemy (Column 15, lines 50-57). Each enemy character has a threshold value set in the form of hit points. When the amount of damage done by the player character is not equal to the threshold value, the player parameter is changed by a first value (Column 15, lines 51-55). When the amount of damage is at least equal to the threshold value and the enemy is defeated, the player parameter is changed by a second value (Column 15, lines 55-59).

The player parameter is associated with the process of gaining items based upon the result of the battle (Column 15, lines 57-59). When the amount of damage is less than the threshold value, Ohnuma et al. do not disclose the exact result but it is inferred that the player parameters relating to the number of items stored for the player is raised by a first value equal to zero

(Column 15, lines 48-51). When the amount of damage is at least equal to the threshold value, Ohnuma et al. disclose that the parameter is raised by a second value, wherein the player can acquire certain items for the win (Column 15, lines 55-59) thus the number of items is increased. Therefore, this parameter can be directly associated with the number of items acquired by the player for the defeat.

Ohnuma et al. disclose a method with different awards for beating and not beating an enemy and the threshold only measures if the player actually defeats an enemy and each player that passes the threshold value is presented with the same parameter, regardless of how well they passed the value. The threshold does not allow a player to achieve greater awards based on how badly the enemy was beat.

Final Fantasy VIII discloses an alternate method of awarding players in a battle situation. Final Fantasy VIII allows a threshold value to be set for a battle against the monsters of the Fire Cavern. The players have a parameter of a SeeD ranking associated with the threshold value and used with the monsters of the Fire Cavern. Once the player defeats the enemies and makes their way through, their performance is compared to the threshold value and the quicker they made it through the more the parameter is changed. If they beat all the enemies but did not do as well against the threshold value, the less the parameter is changed. Thus, even though in both instances the player beat the enemy, the player who did it better is awarded more points.

The teachings of Final Fantasy VIII obviate to a skilled artisan that a player can be awarded not only for beating an enemy, but also for how they do it. Ohnuma et al. does not embrace this concept. A skilled artisan would also understand that a number of ways besides time could be used to establish how well a monster is beat, including for example, how many turns it took, what weapons were used, how much the monster was beat by, or any of the other well-known features of a fighting game. Therefore, it would have been obvious to a skilled artisan to apply the teachings of Final Fantasy VIII to Ohnuma et al. in awarding players for how well they defeat the monster. Though Final Fantasy VIII relates the parameter to time, one of ordinary skill in the art would understand as disclosed above that other parameters could easily be chosen while keeping with the intent of the teachings. Thus, when applying to Ohnuma et al., it would be obvious to use an alternate parameter such as to keep track of how soundly the monster was beat. This would be especially obvious since the awards of Ohnuma et al. are based on this factor, not on time. Currently Ohnuma et al. has the restriction of a reward only upon beating a monster. Therefore, by using the teachings of Final Fantasy VIII, one of ordinary skill in the art would find it obvious to use concept of awarding players for not only beating a monster, but for how well they do it. One of ordinary skill in the art would be motivated to do this in order to keep with the scoring methods of Ohnuma et al. but also to reward players for more than just successful defeats, thus, more advanced players would feel they are truly being

judged and would get more satisfaction than the current method of Ohnuma et al. which awards all players who defeat a monster equally, thus alienating the success of those who not only beat the monster, but do it especially well.

Further applying these teachings to Ohnuma et al. which awards players with items, one of ordinary skill in the art would find it obvious when adhering to the Final Fantasy VIII teachings that a win with greater damage would result in better prizes, thus changing the item parameter by a greater value for greater wins.

Claims 4-5, 16-17 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnuma et al. (US Patent No. 6,375,571) in view of Final Fantasy VIII (FFVIII) further in view of Kondo et al. (US Patent No. 6,347,993).

For clarification the Examiner notes that Final Fantasy VIII, while not specifically mentioned in the 1st line of the rejection regarding claims 4-5, 16-17 and 22-23, was used as a reference to reject the claims in the final rejection mailed on January 21, 2004. These claims are directly dependent from independent claims 1, 13 and 19 all of which have been rejected using Ohnuma and Final Fantasy VIII. Therefore, in order for these dependent claims to be rejected, they must be rejected in view of Ohnuma and Final Fantasy VIII. Consequently, even though there was a typographical error in the final rejection by not mentioning Final Fantasy VIII in the rejection of claims 4-5, 16-17 and 22-23, the claims were considered rejected under Ohnuma in

view of Final Fantasy VIII in further view of Kondo based strictly on their dependency. Therefore, there is no new ground of rejection being raised in this Examiner's Answer.

What Ohnuma et al. and Final Fantasy VIII disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Similar to Final Fantasy VIII disclosed above, Kondo et al. also teaches of a battle method wherein a player character engages with an enemy character. A time threshold is set as the time it would take to defeat the enemy character. The player is also awarded points to help their character develop for each segment of time passed with the number of points being more the closer the player gets to the threshold value of defeating the character (see for example Column 21, lines 13-40). A first number of points is stored if the player performs less than the threshold value and a second number of points is stored if the player meets the threshold. The points obtained by the character are used to supplement parameters to support the character development, growth, and strength.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of Kondo et al. into the system of Ohnuma et al. By applying these teachings, the player character would be rewarded points for their effort in battling the character, not just for defeating the character. One of ordinary skill in the art would be motivated to make this incorporation, as it would provide motivation to the players, as it would reward

them for good attempts, not just for victory. This would keep the players encouraged as well as allow them to slowly develop their character to the point where they will be able to defeat the enemy character, thus promoting play and keeping the interest of the player as they would feel more successful as they would be awarded more often. Further, it would have been an alternative design alternative to award the players different types of items based upon the points obtained as disclosed by Kondo et al.

One of ordinary skill in the art understands that in a role-playing game as disclosed by both Kondo et al and Ohnuma et al., it is notoriously well known in the art that magic or other weapon items can be obtained by reaching a certain point level or acquisition factor. It would have been obvious to one of ordinary skill in the art that as a design alternative to awarding the player points based upon nearness to the threshold value as disclosed by Kondo et al., the players could be awarded different items (as opposed to different points) based upon how close they came to defeating the character. This would be synonymous with the awarding of items disclosed by Ohnuma et al.

Likewise, by awarding points as currently disclosed by Kondo et al., the gaming system is essentially awarding a probability of acquiring an item, as it is disclosed above that it is notoriously well known in the art that acquisition factors are used in awarding items wherein higher acquisition factors are associated with more powerful items, and by awarding points, the system

would be essentially naming the probability value as the points awarded would be a probability function of the total points needed to acquire the item.

Claims 6, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnuma et al. (US Patent No. 6,375,571) in view of Final Fantasy VIII (FFVIII).

For clarification the Examiner notes that Final Fantasy VIII, while not specifically mentioned in the 1st line of the rejection regarding claims 6, 18 and 24, was used as a reference to reject the claims in the final rejection mailed on January 21, 2004. These claims are directly dependent from independent claims 1, 13 and 19 all of which have been rejected using Ohnuma and Final Fantasy VIII. Therefore, in order for these dependent claims to be rejected, they must be rejected in view of Ohnuma and Final Fantasy VIII. Consequently, even though there was a typographical error in the final rejection by not mentioning Final Fantasy VIII in the rejection of claims 6, 18 and 24, the claims were considered rejected under Ohnuma in view of Final Fantasy VIII. Therefore, there is no new ground of rejection being raised in this Examiner's Answer.

What Ohnuma et al. disclose has been discussed above and is incorporated herein.

Though Ohnuma et al. disclose information can be communicated over a network (Column 12, lines 55-57), Ohnuma et al. do not specifically disclose play can commence over the network. However, it is notoriously well known in

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the art and understood by one of ordinary skill in the art that role-playing games can be played over a network wherein players can interact with numerous players from around the world. This feature increases excitement in the game, as there are an endless number of enemies to battle and friends to make. Such a feature would be obvious to Ohnuma et al.

(11) Response to Argument

Re. There is no motivation to combine Ohnuma et al with Final Fantasy VIII.

In response to Appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated in the rejection, one of ordinary skill in the art would find it obvious to use concept of awarding players for not only beating a monster, but for how well they do it. One of ordinary skill in the art would be motivated to do this in order to keep with the scoring methods of Ohnuma et al. but also to reward players for more than just successful defeats, thus, more advanced players would feel they are truly being judged and would get more satisfaction than the current method of Ohnuma et al. which awards

all players who defeat a monster equally, thus alienating the success of those who not only beat the monster, but do it especially well.

In response to that the above motivation is hindsight because the Appellants disclose the same motivation in their specification, the Examiner respectfully disagrees. Viewing the instant specification and the rejection the side by side, the Examiner does not see the same words. The instant specification appears to be correlating a threshold value to a reward. Furthermore, the Appellant does not pin-point where in the instant specification said parallelism lies. Moreover, "pleasure and satisfaction of receiving an award is not what the examiner used as the motivation to combine the references. To reiterate the motivation from the rejections was: **one of ordinary skill in the art would find it obvious to use concept of awarding players for not only beating a monster, but for how well they do it. One of ordinary skill in the art would be motivated to do this in order to keep with the scoring methods of Ohnuma et al. but also to reward players for more than just successful defeats, thus, more advanced players would feel they are truly being judged and would get more satisfaction than the current method of Ohnuma et al. which awards all players who defeat a monster equally, thus alienating the success of those who not only beat the monster, but do it especially well.** Where is this wording located in the instant specification; it is not, it comes from the teachings and suggestions within combination of references, the problem to be solved and the knowledge

base of one of ordinary skill in the art. And in the alternative, to the Appellants' argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Re. The reference has no teaching or suggestion of modifying the calculation to change a parameter based upon a comparison of a threshold and an amount of damage caused by a final fatal attack.

The limitations of Claim 1 that are pertinent to this contention are as follows:

...

comparing an amount of damage inflicted on the enemy character by the player character, immediately before the player character defeats the enemy character, with a threshold value previously set for the enemy character;

changing the parameter stored in a storage device according to a first condition, when the enemy is defeated by an amount of damage that is less than the threshold value; and

changing the parameter stored in the storage device according to a second condition that is different from the first condition, when the enemy is defeated by an amount of damage that is at least the threshold value.

As seen from above the language in the contention is inconsistent with the language of the claim. Changing a parameter based on a comparison of a

threshold and an amount of damage caused by a final fatal attack is not what is claimed. What is claimed is **changing the parameter stored in the storage device according to a second condition that is different from the first condition, when the enemy is defeated by an amount of damage that is at least the threshold value.** No “final fatal attack” or the like is used in the claim. Therefore, the contention is not commensurate with the claim language and thus is unpersuasive. If the Appellant would like to amend the claim to reflect this contention, then the Examiner would have to reconsider this argument along with the prior art.

Re. The combination of Ohnuma et al. and FFVIII does not teach or suggest all of the limitations of Claims 1, 13 or 19.

Here the Appellants contention that “the applied references do not teach or render obvious to one having ordinary skill in the art [1] a data storage medium recording a video game program, [2] the program causing the computer to change a parameter based upon a comparison of damage inflicted immediately before the enemy character is defeated.” In response, the Examiner directs the Appellants attention figure 6 of Ohnuma et al. where this reference show an optical disk, this is the data storage medium that has a video game program stored thereon. With respect to the latter part of the above contention, although the claims are rejected under obviousness over a combination of references and thus the combination must be viewed in whole, the Examiner wishes to direct attention to certain portions of Ohnuma et al.

which counter the latter part of the contention above. In col. 11:40-47 and 57-66, the parameter changing means is described in part:

Specifically, the number indicates a rate for changing the parameter of the magic power of the selected magic spell or magic item. The number will be referred to as the changing rate. The degree of changing the magic power is determined by the changing rate. In FIG. 10, for example, the initial value "100%" of the parameter is shown on the display monitor 18. The value "100%" indicates the basic power of the selected magic spell or magic item.

Specifically, in order to increase the effect of the magic attack, it is necessary for the user to press the decision button 112d rapidly as many times as possible. The number of button pressings by the user is counted such that the changing rate reflects the counted number. In FIG. 11, if the user presses the decision button 112d five times, for example, the changing rate is increased up to 110%. If the changing rate is increased up to 200% by pressing the decision button 112d multiple times, the damage points of the magic attack is increased to be twice as large as the basic damage points of the magic attack.

The first portion of the above quoted text discloses the base or first condition when for the parameter of spell power, i.e. the amount of damage will be applied to the enemy. The second portion discloses the change in the parameter of spell power based upon an action by the player, which in turns means a larger amount of damage will be applied to the enemy. In this case a change in parameter of spell power changes a parameter of graphic effect, sound effect and vibration effect, see col. 12:1-7 "when the button icon 204 is displayed on the monitor

18, the user can increase the changing rate of the magic power by pressing the decision button 112d multiple times so as to increase the damage points of the magic attack. At this time, the levels of the respective graphic effect, sound effect, and vibration effect are also increased based on the changing rate.” Thus a change to a parameter based upon a comparison of damage inflicted is disclosed. Eventually, the enemy will be defeated so logically the comparison will be made immediately before the enemy character is defeated. Again, this is just a response to the contention raised and the rejection above is the proper interpretation of how the prior art of record deem the claimed invention as obvious.

Re. FFVIII does not teach determining whether a monster and task are beat with more skill. Rather, FFVIII only teaches rewarding a player based upon how well [the player] estimated the task would take to complete.

The claim recites in the later portions “when the enemy is defeated by an amount of damage that is at least the threshold value.” In the world of video games “the enemy” is understood by one of ordinary skill in the art as a challenge that needs to be overcome by the player in order to move to the next level. This “challenge” could be to solve a puzzle, defeat a monster, run through an obstruction to reach the other side. When viewing in the totality, FFVIII teaches and suggests defeating “the enemy” quickly by moving through the Fire Cavern at a faster pace rewards the player with a better chance to earn a higher SeeD ranking.

Responding to specific contentions raised in this section of Appellants' Brief. In response to the contentions that FFVIII does not measure how well a player defeats the enemy, the Examiner response with FFVIII does measure: the quicker the player moves through the cavern, which as described above can be understood as "the enemy" to one skilled in this art, the greater the reward, i.e. in the specific FFVIII embodiment taught the player has a greater chance of moving up to a higher SeeD rank, which is the total objective to the game itself: to get a high SeeD ranking. In response to the contention that FFVIII does not analyze whether a player did a better job of beating the enemy and task, the Examiner responses with FFVIII does analyze whether the player did a better job. If the player moves quicker through the cavern, then the player has a better chance of earning a higher SeeD ranking. The game system has to inherently do some comparison as to whether the player move quickly thought the cavern, either by comparing the time to a table of times or comparing the time to an amount of time inputted by the player prior to start through the cavern. Either way an analysis by FFVIII is done to see if the player did a better job of beating the enemy or task, than what is tabulated or inputted prior to starting the cavern. In response to FFVIII does not teach determining whether a monster and task are beat with more skill, this is respectfully not claimed in the claims under appeal. Moreover, the Examiner respectfully disagrees that FFVIII does not suggest determining whether a monster and task are beat with more skill. Viewing the FFVIII as a whole, if a player proceeds

quicker through the cavern, then the player has a better chance of earning a higher SeeD ranking. It appears logical that FFVIII has to make a determination where the player proceeded quicker through the cavern in order to determine whether there is a chance the player would receive a higher SeeD ranking. This determination could be through comparing the actual time the player took to complete the cavern to a predetermined time either from a table or from a player's input prior to starting through the cavern, either way a determination by FFVIII has to be made.

Re. The combination of Ohnuma et al. and FFVIII does not teach or suggest all of the limitations of Claims 3, 15 or 21.

The Appellants contended that the references fail to teach or suggest “a computer readable medium wherein the parameter comprises the numbers of items acquired by the player, and the changing increases the number of items by a first number when the amount of damage is less than the threshold, and the changing increases the number of items by a second number greater than the first number when the amount of damage is at least the threshold.” In response, the Examiner directs Appellants attention to, for example, Ohnuma et al. where in col. 15:55-59, it is explain upon the monster reaching zero hit points, the amount of damage is at least at the threshold, the player acquires a larger number of items, “gold and experiences” versus nothing if the main character (200) reaches zero before the monster(s) (202). Thus, the parameter, in this case the number of items, is increased when the threshold value, zero

hit points for the monster, is reached versus a first number of items, which is zero if the monster is not at zero or the player's character reaches zero first. Responding to the Appellants interpretation of page 6 of the January 21, 2004, Office action, the statement is directed to the totality of what one of ordinary skill in the art would conclude based on viewing the references as a whole given their knowledge in this art and not singly to one reference as Appellants appear to make in their contention herein.

Re. The combination of Ohnuma et al., (FFVIII) and Kondo et al. does not teach or suggest all the limitations of Claims 4, 5, 16, 17, 22 or 23.

Firstly, claim 4 and those like it appear to be similar to claim 3 and its kindred; the claims are just couched differently, i.e. instead of calling a limitation a "thingamajig" the synonymous word of "watchumacallit", see Rogert's Thesaurus under the term "gadget", is used. Therefore, a skilled artisan in this art understanding that the material within claims 3 and 4 are synonymous would be inclined to understand that the art of record as described and applied to claim 3 et al. would equally apply to claim 4 et al.

Secondly, the Appellants appear to contend that the Examiner lack providing objective evidence in rejecting these claims. Respectfully, the Examiner disagrees. The Examiner directs the Appellants' attention to the rejection, which uses Kondo et al. as the teachings and suggestions to find the claim invention herein as obvious. The rejection explains that Kondo et al. is being used to provide the objective evidence. The rejection specifically, as an

example of how the limitations are found obvious in view of the prior art of record, to col. 21:13-40, to provide a basis of fact to support the positions and explanations given as to why one of ordinary skill in the art would find these limitations as obvious. The Examiner's assertions are not "naked" as the Appellants' opine; the Examiner provide Kondo et al. which it appears the Appellants have forgotten was used in this rejection. There appears to be just a disagreement in reasonable minds as to what is taught and suggested by the prior art of record; and on the issue of obviousness *vel non*, when it is close reasonable minds will differ.

Furthermore, the Appellants own remarks give support for the Examiner's position that the Appellants' plurality of claims are no more than synonymous versions of the same concept and are just couched differently. For example, when arguing the merits of claim 5, the Appellant tacitly admit that probability equates to acquisition factors. Thus, it can be reasonably stated that the limitations found in claims 3, 4, 5 and the associated claims are to the same concept albeit couched different and the Examiner has thoroughly explained how claim 3 is met by the prior art of record and this reasoning carries forward to claims 4 and 5 et al.

With respect to the Appellants' contention of points *vis-à-vis* probability and acquisition factors and the former is deterministic whereas the latter is stochastic, the disclosed invention does not appear to get into such a detail analysis. Viewing the drawings, the Examiner doesn't see probability tables or

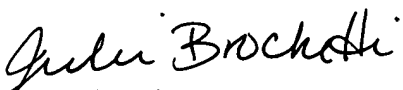
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functions. Likewise, reading the instant specification said tables and functions are not present. Thus, in this case, the Appellants arguments are more detailed than the disclosed invention; hence, these arguments are not commensurate in scope to the invention and are not persuasive.

(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


Julie Brockett
September 12, 2005

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